

REMARKS

CLAIM REJECTION – 35 USC § 103

The OA on page 2 rejected claims 1-3, 7-9, 13-15 and 19 under 35 USC §103 as being unpatentable over Go Daddy, www.godaddy.com, 02 February 2003 (hereinafter “prior Go Daddy service”) in view of Chauchard et al. US 20020042719 (hereinafter “Chauchard”). Applicant respectfully traverses this rejection.

Claim 1

I. Not all limitations taught for claims 1, 7, 13 and 19

The OA on page 3 states:

Go Daddy does not teach; however, Chauchard teaches
C) assisting the Entrepreneur in trademarking a name, wherein the Facilitator's web site is accessible to a plurality of Entrepreneurs over the Internet (paragraphs 75-80).

Applicant respectfully traverses this rejection because at least three limitations in step C) of claim 1 are not taught by Chauchard (or the prior Go Daddy service). Thus, the prior art fails to establish prima facie obviousness, which requires that all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03; In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Applicant submits that not all the claimed limitations are either taught or suggested by the cited prior art. Specifically, Chauchard and the prior Go Daddy service does not teach all of claim 1, step C). Since at least step C) is not taught or suggested by the prior art, Applicant respectfully requests the withdrawal of this rejection.

1. **Prior art does not teach assisting an Entrepreneur [who has a domain name registered by a Facilitator's web site] in trademarking the domain name or label [of the domain name].**

Chauchard teaches a process for assisting an applicant on a local computer to perform a trademark process. There is no teaching in Chauchard of the applicant registering a domain name. Thus, Chauchard does not teach the limitation of an "Entrepreneur" as an "Entrepreneur" in claim 1, step B) has a domain name registered by a Facilitator's web site.

The prior Go Daddy service teaches, among other things, a process for assisting a customer to perform a domain name registration process. However, there is no teaching in the prior Go Daddy service of the customer trademarking a domain name or label [of a domain name.] Thus, the prior Go Daddy service also does not teach the limitation of an "Entrepreneur" as an "Entrepreneur" in claim 1, step C) has a domain name or label [of a domain name] trademarked by a Facilitator's web site.

In contrast to Chauchard and the prior Go Daddy service, claim 1, step C) recites "assisting the Entrepreneur [who has a domain name registered by a Facilitator's web site in step B)] in trademarking the domain name or the label [of a domain name.] Since neither Chauchard nor Go Daddy teaches the claim limitation of an "Entrepreneur" as defined in claim 1, step B) (registering a domain name) AND step C) (trademarking a domain name or label [of a domain name]), Applicant respectfully requests the withdrawal of this rejection.

2. **Prior art does not teach an Entrepreneur trademarking the domain name or the label [of a domain name].**

The OA on page 3 states “Chauchard teaches C) assisting the Entrepreneur in trademarking a name.” (underlining added) This is an incomplete statement of claim 1, step C). Claim 1, step C) actually claims “assisting the Entrepreneur in trademarking the domain name or the label [of a domain name]”, not just “a name” as incorrectly stated in the OA.

Chauchard teaches a process for assisting a trademark applicant on a local computer to perform a trademark process. There is no teaching in Chauchard of the applicant trademarking a domain name or the label [of a domain name.] Thus, Chauchard does not teach the limitation of “trademarking the domain name or the label [of a domain name]” as recited in claim 1, step C).

The prior Go Daddy service teaches, among other things, a process for assisting a customer in performing a domain name registration process. However, there is no teaching in the prior Go Daddy service of the customer trademarking a domain name or label [of a domain name.] Thus, the prior Go Daddy service also does not teach the limitation of “trademarking the domain name or the label [of a domain name]” as recited in claim 1, step C).

In contrast to Chauchard and the prior Go Daddy service, claim 1, step C) recites “assisting the Entrepreneur in trademarking the domain name or the label [of a domain name.]” Since neither Chauchard nor Go Daddy teaches the claim limitation of trademarking a domain name or the label [of a domain name] as recited in claim 1, step C), Applicant respectfully requests the withdrawal of this rejection.

3. **Prior art does not teach a Facilitator's web site [that assists Entrepreneurs in preparing trademark applications.]**

The OA on page 9 states "Go Daddy supplies what Chauchard is lacking – the website." (underlining added) Applicant respectfully disagrees as the limitation is not merely a "website" or even a "Facilitator's web site." Claim 1, step C) includes the limitation of "the Facilitator's web site assisting the Entrepreneur in trademarking the domain name or the label [of the domain name]."

Chauchard teaches a process for assisting an applicant on a local computer to perform a trademark process. There is no teaching in Chauchard of the applicant trademarking a domain name or the label [of a domain name] from a Facilitator's web site. Thus, Chauchard does not teach the limitation of "the Facilitator's web site assisting the Entrepreneur in trademarking the domain name or the label [of a domain name]" as recited in claim 1, step C).

The prior Go Daddy service teaches, among other things, a process for assisting a customer to perform a domain name registration process. There is no teaching in the prior Go Daddy service of its website assisting a customer in trademarking a domain name or label [of a domain name]. Thus, the prior Go Daddy service also does not teach the limitation of "the Facilitator's web site assisting the Entrepreneur in trademarking the domain name or the label [of a domain name]" as recited in claim 1, step C).

Since neither Chauchard nor the prior Go Daddy service teaches the claim limitation of "the Facilitator's web site assisting the Entrepreneur in trademarking the domain name or the label [of a domain name]" as recited in claim 1, step C), Applicant respectfully requests the withdrawal of this rejection.

Claims 7, 13 and 19

Independent claims 7, 13 and 19 should be allowed at least for the same reasons as claim 1. Thus, Applicant respectfully requests the withdrawal of the rejection for claims 7, 13, 19.

Claims 2-6, 8-12 and 14-18

Claims 2-6, 8-12 and 14-18 depend from independent claims 1, 7 and 13 respectively which are believed allowable. Thus, claims 2-6, 8-12 and 14-18 should be allowed at least for this reason.

II. Response to the OA's Response to Arguments

The OA on page 10 states:

To clarify, Examiner asserts that at the time of the applicant's invention, it would have been obvious to use a web site, rather than a "mere" software program to provide assistance in filing a trademark, particularly as the USPTO provides an online manner of filing trademarks since at least 29 February 2000 (see the prior art provided with previous Office Action).

Applicant respectfully disagrees. Even if the USPTO had a website that permitted online filing of trademark applications, that does not teach a trademark applicant being assisted by a website in trademarking a domain name or label [of a domain name] with the USPTO's website.

In contrast, the claims call for an Entrepreneur to use a Facilitator's web site to assist in trademarking the domain name or label [of a domain name] with the USPTO. The prior art of Chauchard shows that trademark applicants were using local computers to contact the USPTO's website, not the claimed Facilitator's web site.

The OA on page 11 states "[i]n KSR, the Supreme Court particularly emphasized 'the need for caution in granting a patent based on the combination of elements found in the prior art.'" (underlining added) Applicant respectfully submits that KSR is not applicable. At least three elements are not found in the prior art as explained above in sections 1, 2 and 3. Thus, the claims are not a "combination of elements found in the prior art" as at least three elements (when all of the words of the claims are considered as required by In re Wilson) are not shown in the prior art.

The OA on page 11 states "In United States v. Adams, . . . [t]he Court recognized that when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield predictable results." Applicant respectfully submits that Adams is also not applicable. Sections 1, 2 and 3 above show at least three "structures" that are not known in the prior art and these differences with the prior art are not due to a "mere substitution of one element for another known in the field." The differences between the claims and the prior art have to do with limitations on the claim elements and in the interrelatedness of the structures.

The OA on page 12 states "In Anderson's Black Rock, Inc. v. Pavement Salvage Co., . . . [t]he two [pre-existing elements] in combination did no more than they would in separate, sequential operation." Applicant respectfully submits Anderson is also not applicable. Again, sections 1, 2 and 3 above show that not all the elements are "pre-existing elements." The

invention is not merely combining known elements as was done in Anderson, but in limiting and causing interrelationships between the elements that are not shown in the prior art. Specifically, the claim limitations have been customized and enhanced to work together to create synergies, and are not merely known structures claimed together. Thus, because not all the elements are pre-existing elements when all the words in the claim are considered, Applicant respectfully requests the withdrawal of this rejection.

The OA on pages 12 and 13 state the following two rationales apply to support the conclusion of obviousness.

- (A) Combining prior art elements according to known methods to yield predictable results;
- ...
- (E) 'Obvious to try' – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

Rationale (A) requires “combining prior art elements.” However, as shown in sections 1, 2 and 3 above, when considering all the words of a claim, at least three elements of claim 1 are not known “prior art elements.” Thus, rationale (A) does not apply.

Rational (E) requires “choosing from a finite number of identified, predictable solutions.” However, as shown in sections 1, 2 and 3 above, the differences between the claim limitations and the prior art have to do with structural limitations and interrelationships between the elements that are claimed, but not shown in the prior art, and thus cannot be characterized as merely being a “finite number of identified, predictable solutions.”

The OA on page 13 states “[t]he only difference in the prior art and the instant invention is the combination of the elements into a single website.” Here, the OA admits that the instant invention is not shown in the prior art for at least the reason that the prior art does not show all the steps being performed by a single website, i.e. the claimed “Facilitator’s web site.” The rejection should be withdrawn for at least this reason. In addition, sections 1, 2 and 3 above illustrate that there are more differences between the prior art and the instant invention than merely combining known elements into a single website.

The OA on page 14 states “Applicant asserts that the motivation to combine appears to come from the application. However, he does not recite any specific passages which support his statement.” To correct this situation, Applicant points to page 14, second paragraph which states “[t]he placement of a plurality of tools on a Facilitator’s web site 105 necessary for creating an Internet business greatly assists the Entrepreneur 101 in completing more of the recommended

steps and completing the steps in a much shorter time frame than with the ad hoc approach used by Entrepreneurs in the prior art.” Thus, the motivation to combine cited in the OA is actually first stated in the Applicant’s specification. The OA has not stated where it independently found the same motivation to combine. Thus, Applicant respectfully submits that it is not proper to state it would not have been obvious to combine Chauchard and the prior Go Daddy Service to create the instant invention based on a motivation to combine found only in the specification.

CONCLUSION

Applicant respectfully submits that Go Daddy and Chauchard do not teach all the claim limitations as explained above. Applicant thus requests the allowance of all pending claims, i.e. claims 1-19, as soon as possible. Any questions or suggestions regarding this Amendment should be directed to the undersigned attorneys for Applicants at the telephone number or email address listed below.

Respectfully submitted,

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